Supreme Court, U. S.
FILED
JAN 21 1980
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

No. 79-1088

KENNETH ANDREW BORA,
Petitioner

v.

MITCHELL BROTHERS FILM GROUP, *et al.*,
Respondent

Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

SUPPLEMENTAL APPENDIX

MELVYN C. BRUDER
BENNIE R. JUAREZ
4308 North Central Expressway
Suite 210
Dallas, Texas 75206

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

DISTRICT COURT
N. D. TEXAS
DALLAS DIV.

No. 3-74-645

MITCHELL BROTHERS FILM GROUP, *et al.*

v.

CINEMA ADULT THEATER, *et al.*

Decided Sept. 2, 1976

Action by Mitchell Brothers Film Group and Jartech, Inc., against Cinema Adult Theater, Kenneth Bora, et al., for copyright infringement. Judgment for defendants.

Hill, District Judge.

Mitchell Brothers Film Group (Mitchell Brothers) and Jartech, Inc., (Jartech), plaintiffs, seek injunctive relief and damages against several defendants who allegedly are unlawfully displaying a motion picture film on which plaintiffs claim a copyright. Plaintiffs contend that the movie was produced by Jartech and that Mitchell Brothers is the exclusive distributor of the film under a distributorship agreement. Plaintiffs assert a cause of action based on a claim of infringement of a copyright they possess on the movie, a claim of unfair competition, and a claim of interference with the contractual relationship between the plaintiffs.

Defendants are the operators of a theater in Dallas, Texas. Defendants contend that plaintiffs' asserted copyright is not valid because the movie is obscene, it does not bear a proper copyright, the copyright was secured through fraud on the Copyright Office, and the movie was

in the public domain prior to issuance of the copyright. Plaintiffs' cause of action is founded on the validity of the copyright in question and if it is invalid or otherwise unenforceable then plaintiffs' suit must fail. After considering the evidence, stipulations of the parties, briefs and arguments of counsel, the court is of the opinion that the relief sought by plaintiffs should be denied.

Factual Background

In 1972 Jartech produced a movie in California titled "Behind the Green Door." During a part of 1972 the movie was shown to audiences at a theater in San Francisco which was owned by James Mitchell and Artie Mitchell, who are brothers and the principal owners of Jartech and the principals of Mitchell Brothers. The movie was shown to test its acceptance by the general public. During this showing the movie bore a notation that it was copyrighted although at the time it had not been registered with the Copyright Office. The film used in this showing was a "first answer print" rather than a "release print," which is the type of film print normally utilized after a movie is copyrighted and distributed for general exhibition to the public.

In early 1973 the sound effects and music of the movie were changed. Jartech then registered the movie with the United States Copyright Office. The registration certificate reflects that the movie was published on April 18, 1973. The application for copyright registration describes the film as a motion picture "other than a photoplay," which is a film that has no plot, such as a newsreel, travelogue, promotional film and nature study film, as contrasted to a "photoplay" film, which includes movies that are dramatic and have a plot or tell a story. James Mitchell testified that he viewed the movie "Behind the Green Door" as a documentary, that it educated viewers regarding sex and that it did not have a plot or story.

He further testified that viewers of the movie had different reactions as to whether it told a story or had a plot. For these reasons he caused the movie to be described in the application for copyright as "other than a photoplay."

On February 1, 1973, Jartech and Mitchell Brothers entered into a Distribution Agreement whereby Mitchell Brothers was granted the exclusive right to distribute and exhibit "Behind the Green Door." Thereafter Mitchell Brothers licensed the movie for exhibition to the general public at movie houses across the country.

The defendant Kenneth Bora operates the Cinema Adult Theater in Dallas. Bora acquired several copies of the movie in dispute and he commenced exhibiting it at his theater. Bora did not acquire the movie from the plaintiffs nor did he possess it with plaintiffs permission. Plaintiffs advised Bora that the movie he was displaying at his theater was a "pirated" copy and they demanded that he cease exhibiting it. Bora did not do so, however, until after this suit was filed and this court issued an injunction against him. At one time Bora excised explicit sexual scenes in the movie and he then exhibited the movie in this edited form to patrons of his theater.

The court has viewed the copy of the film the plaintiffs filed with the Copyright Office, a copy of the film that Bora obtained and exhibited at his theater, and the portions of this movie that Bora excised. The film acquired by Bora bore a copyright but it was dissimilar to the copyright on the plaintiffs' film filed with the Copyright Office. The dominant theme of the movie is the portrayal of various sexual acts by a female person with a multitude of persons, both male and female. The movie portrays the genital parts of both sexes, acts of fellatio and cunilingus, and seminal fluid.

Defendants Contentions

When the defendants exhibited plaintiffs' movie at their theater they infringed the copyright. Section 1 of the Copyright Act gives the owner of a copyright the exclusive right to print, reprint, publish, copy and vend the copyright work for a term of years. The defendants did not have permission to use or exhibit the movie, and when they projected an image on a screen from the film of the movie they caused a copy of the film to be created and violated the provisions of Section 1. Patterson v. Century Productions, 93 F.2d 489, 493, 35 USPQ 471, 474-475 (2nd Cir. 1937).

Defendants contend, however, that the copyright is invalid because plaintiffs secured it through fraud on the Copyright Office by describing the movie in the application for registration as "other than photoplay" when in fact it is a dramatic work and has a plot and therefore should have been described as a "photoplay." Defendants further urge that when the movie was exhibited in 1972 in San Francisco it was done without limitation or restriction and that it could not thereafter be registered and copyrighted because it was then in the public domain. Also, defendants contend that the movie failed to contain a proper copyright mark and therefore is not entitled to the protection of the Act. The court is of the opinion that these contentions are without merit and do not invalidate the copyright protection for this movie.

Defendants' first contention is that the plaintiffs committed fraud on the Copyright Office. The court is of the opinion that the movie can be described as having no plot or structured story and that the description of the movie by the plaintiffs as "other than photoplay" is not an incorrect classification. Assuming that this description was incorrect, there has been no showing that it was an intentional act on the part of the plaintiffs which was tainted with fraud, or that it was done with the intent

to deceive the Copyright Office. Further, Section 5 of the Act calls for the classification of works and it sets out certain classes and requires that the application for registration specify under which class the work belongs. The last sentence of section 5 states that any error in classification shall not impair the copyright protection afforded by the Act. Thus any misstatement in the application in describing this movie would not be grounds to invalidate the copyright protection that the movie might otherwise enjoy. Peter Pan Fabrics, Inc. v. Dan River Mills, Inc., 295 F.Supp. 1367, 161 USPQ 119 (S.D.N.Y. 1969), affirmed 415 F.2d 1007, 163 USPQ 670 (2nd Cir. 1969); Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354, 73 USPQ 317 (9th Cir. 1947); Tiffany Productions v. Dewing, 50 F.2d 911, 9 USPQ 545 (D. Maryland 1931).

Defendants' second contention is that the movie was in the public domain before its registration with the Copyright Office. It is true that the general publication without restriction of a literary or other work with the consent of the creator or proprietor places the work in the public domain and it is not copyrightable. However, a limited or qualified publication of a work by the creator or one acting under him will not prohibit a later copyrighting of such work. Baker v. Selden, 101 U.S. 841 (1879); Harold Lloyd Corp. v. Witiver, 65 F.2d 1, 24 (9th Cir. 1933), cert. dismissed 78 L.Ed. 1507. A publication or showing of a work with only the right to view or inspect it without more is not necessarily a general publication. Patterson v. Century Productions, supra. Likewise, a limited publication to a select group and for a limited purpose and without the right to reproduce, distribute, or sell the work will not be construed as a general publication abrogating the right to copyright the work at a later time. Williams and Wilkins Co. v. United States, 487 F.2d 1345, 180 USPQ 49 (U.S. Ct. of Claims 1973); White v. Kimmell, 193 F.2d 744, 92

USPQ 400 (9th Cir. 1952). Nor is an exhibition or showing of a work to get a reaction or opinion a publication that constitutes a dedication to the general public. Key West Hand Print Fabrics, Inc. v. Serbin, Inc., 269 F. Supp. 605, 610, 155 USPQ 130 (S.D. Fla. 1966), affirmed 381 F.2d 745, 115 USPQ 113 (5th Cir. 1967).

The court is of the opinion that the showing of the movie in 1972 was a restricted or limited showing. This showing was to test the acceptance of the movie by the general public. Further, the movie was not distributed at this time to any other exhibitor nor were any copies of the film sold. As a result of this showing the sound track and music of the movie were altered. In addition the film that was utilized in this showing was not the permanent type of film print that is used when a movie is released for general distribution to the public. Although the movie was not registered with the Copyright Office in 1972 and the copyright notice on the movie may not have created any copyright protection in favor of the plaintiffs, it was nevertheless a public expression by the plaintiffs that the exhibition was intended to be limited or restricted. For the foregoing reasons the court is of the opinion that the movie was not in the public domain before its registration with the Copyright Office in 1973 and that the copyright is not invalid for that reason.

The copy of the movie viewed by the court which was filed with the Copyright Office does bear a proper copyright notice and the defendants' third claim that the copyright is invalid because of an improper copyright mark is without merit.

Defendants finally and strenuously urge that the movie is obscene and the powers of this court should not be invoked to enforce the copyright protection to which the movie would normally be entitled. In deciding this issue the court must first determine whether obscenity is a valid defense to plaintiffs' case, and, if so, what standards should be used in deciding whether the movie is obscene.

Section 8 of Article I of the United States Constitution empowers Congress "To promote the Progress of Science and Useful Arts." Pursuant thereto Congress enacted the Copyright Act (Title 17 U.S.C.). In Section 4 it is provided that works which are subject to a copyright "shall include all the writings of an author." Except for this language the Act is silent as to works which are subject to registration and copyright. The courts, however, have held that some works are not entitled to copyright protection.

In Mazer v. Stein, 347 U.S. 201, 100 USPQ 325 (1954) the Supreme Court held that the Copyright Act was intended to afford those who create a work a valuable protection in the work and at the same time "to afford greater encouragement to the production of literary (or artistic) works of lasting benefit to the world." The court stated:

> The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "science and useful arts." Sacrificial days devoted to such creative activities deserve rewards commemorative with the service rendered. (347 U.S. at 219, 100 USPQ at 333.)

This was also the rationale of the Supreme Court in Baker v. Selden, supra, when the court refused to grant copyright protection to a book the object of which was to exhibit and explain a bookkeeping system. The court emphasized that the purpose of the Copyright Act then enacted was the promotion of the sciences and that a work which did not do so was not entitled to copyright

protection. In Stone & McCarrick, Inc. v. Dugan Piano Co., 220 F. 837 (5th Cir. 1915), the Fifth Circuit, relying on the doctrine of clean hands, refused to grant copyright protection to materials which were found to be false and fraudulent.[1]

Although few in number, and not of very recent vintage, in those cases where obscenity has been raised as a defense, the courts have uniformly recognized that an obscene work will not be afforded copyright protection by the courts. Martinetti v. Maguire, 16 F.Cas. 920 (No. 9173) (C.C.Cal. 1867), Barnes v. Minen, 122 F. 480 (C.C.S.N.Y. 1903); Bullard v. Esper, 72 F.Supp. 548 (N.D.Tex. 1947); Khan v. Leo Feist, Inc., 70 F.Supp. 450, 73 USPQ 104 (S.D.N.Y. 1947); Broder v. Zeno Mauvis Music Co., 88 F. 74 (C.C.N.D. Cal. 1898); Simonton v. Gordon, 12 F.2d 116 (S.D.N.Y. 1925); Cain v. Universal Pictures Co., Inc., 47 F.Supp. 1013, 56 USPQ 8 (S.D. Cal. 1942). See, 41 Opinions of the Atty. Gen. No. 73 (1958), 121 USPQ 329 (1959), wherein it is opined that the Registrar of Copyrights, while authorized to deny registration to obscene works as he may to other noncopyrightable works, is "free to decide not to attempt to refuse or deny registration of claims to copyrights in works of the nature here discussed." Also, writers on the subject agree that obscene or immoral matters are not the subject of copyright protection. I. Nimmer, Copyright (1972), § 36 at 146.28; Rogers, Copyright and Morals, 18 Mich. L. Rev. 390 (1920); Comment, Immorality, Obscenity and the Law of Copyright, 6 S.Dak. L. Rev. 109 (1961); Copyright Protection for Motion Pictures: Limited or Perpetual, American Society of Composers, Authors and Publishers, 1970 Copyright Law Symposium #18, p. 174. The rationale of the decisions

[1] In Belcher v. Tarbox, 486 F.2d 1087, 180 USPQ 1 (9th Cir. 1973), the court, with one judge dissenting, refused to follow the Fifth Circuit and held that materials which might be fraudulent or false were still entitled to copyright protection.

is that a court of equity will not lend its support to one with unclean hands and for purposes that are contrary to the public interest. Morton Salt Co. v. G. S. Suppiger Co., 314 U.S. 488, 494, 52 USPQ 30, 33 (1942).

Literary and other works that contain references to and explicitly exhibit sexual activities have inundated society in the past few years. One would think that the courts would have been called upon quite frequently in recent times to reexamine the long standing prohibition against granting copyright protection to obscene and immoral works, but such has not been the case. Thus, the judicial rule proscribing protection to an obscene work remains unchallenged and in the opinion of the court should be followed in deciding this case.

Most states have laws making it a crime to display or exhibit obscene materials. The federal government has also condemned the interstate transportation, mailing and importation of obscene works. Thus, the general feeling as reflected in statutory enactments is that obscene matters do not further public welfare or public interest or promote the progress of science or useful arts as called for in the empowering clause of the Constitution. Therefore "Sacrificial days" devoted to the production of works which do not advance the public interest or welfare are not entitled to the rewards provided for in the Copyright Act and to judicial protection.

By granting copyright protection to obscene matters it could be urged that they would not be so easily copied and thereby disseminated to the general public. More compelling in the court's mind is the argument that in refusing copyright protection the creator would have no guarantee of exclusiveness to his product and the rewards that flow therefrom and this would thereby tend to inhibit the creation of works which are obscene.

Plaintiffs argue that since the movie is registered with the Copyright Office a presumption is created that it is a

proper subject for copyright and it cannot be challenged on the grounds that it is an obscene work. The court disagrees. Copyrights and patents are subject to judicial attack. Even assuming that the registration creates some form of presumption in plaintiffs' favor, the presumption imposes on the defendants the burden of going forward with the evidence to rebut the presumption, but there would still be imposed on the plaintiffs the burden of establishing the validity of their copyright. Rule 301, Fed. Rules of Evid.

Having concluded that the movie is not entitled to protection as a copyrighted work if it is obscene, the court must next determine what standards should be applied in deciding whether the movie is obscene. In Miller v. California, 413 U.S. 15 (1973) the Supreme Court recognized that contemporary community standards were to be applied in testing the obscenity vel non of a material. The testing by community standards was also adhered to in the earlier cases of Memoirs v. Massachusetts, 383 U.S. 413 (1966) and Roth v. United States, 354 U.S. 476 (1957). Thus, in those cases where it has been determined that the First Amendment does not immunize a person from criminal sanctions when dealing with obscene materials, the Supreme Court has ruled that local standards are to be used in determining whether a material is obscene. Therefore, the issue arises here whether a different standard should be applied in adjudicating an obscenity defense to a suit for copyright infringement. The underlying purpose of the Copyright Act is to grant protection throughout the United States, and therefore the Copyright Act is national in scope and application. Goldstein v. California, 412 U.S. 546, 178 USPQ 129 (1973). From this premise it is arguable that a national obscenity standard should be applied, otherwise what might be obscene in Dallas and not protected by the Copyright Act might not be obscene in San Francisco

and gain the Acts protection.[2] However, it is the opinion of this court that the pronouncements of the Supreme Court defining obscenity should govern this issue in copyright cases. There is no reason for a national definition of obscenity to be applied in copyright cases when a local standard is applied in criminal obscenity cases. While the Copyright Act is national, so is the First Amendment upon which defenses to criminal obscenity charges are founded.

At the time this movie was produced and registered with the Copyright Office the Roth-Memoirs guidelines were the tests utilized in determining obscenity. For a matter to be obscene under those guidelines it was required that (1) the dominant theme, taken as a whole, appeal to a prurient interest in sex; (2) the material be patently offensive because it affronts contemporary community standards relating to the description or representation of sexual matters; and (3) the material be utterly without redeeming social value. Shortly after

[2] In Cain v. California, supra, in determining whether a copyright encompassed obscene materials the court adopted standards applicable to the federal statute banning obscene materials from the mails, 18 U.S.C. § 1461. In Bullard v. Esper, supra, the court adopted the standards applicable to the banning of obscene materials from interstate transportation by carriers, 18 U.S.C. § 1462. Other courts have adopted different standards. In Khan v. Leo Feist, Inc., supra, the court in a copyright case examined the work to see if "there was a purpose to corrupt the morals of hearers, or to stimulate thoughts or impulses which would otherwise be dormant." In United States v. One Book Entitled Ulysses, 72 F.2d 705 (2nd Cir. 1934), the court was called upon to determine whether a book was obscene within federal statutes prohibiting importation of obscene materials. The court held that the applicable test was whether the book taken as a whole has a libidinous effect. In Simonton v. Gordon, 12 F.2d 116 (S.D.N.Y. 1925), the court held in a copyright infringement suit that immorality of the copyrighted work as a defense cannot be maintained unless the work was calculated to arouse lust in those who read or viewed it. It is apparent from a review of the earlier cases that there has been no uniformity by the courts in applying standards by which materials are to be judged in determining whether they are obscene.

this movie was filed with the Copyright Office, the Supreme Court handed down its decision in Miller v. California. In that case the court held that the guidelines for determining whether material was obscene were (1) whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to the prurient interest; (2) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (3) whether the work, taken as a whole, lacks serious literary, artistic, political or scientific value. Since this movie was produced when the Roth-Memoirs guidelines were in effect but was exhibited by the defendants when the Miller guidelines were in effect, an issue is raised as to which guidelines should be utilized at this time in determining whether the movie is obscene.

In United States v. Thevis, 484 F.2d 1149 (5th Cir. 1973), cert. denied, 418 U.S. 932, the Fifth Circuit held in a criminal prosecution under a federal obscenity statute that if the acts charged occurred while the guidelines enunciated in Roth-Memoirs were effective but the trial occurred while the guidelines enunciated by Miller were effective, then the defendant was entitled to the benefit of both guidelines. If materials were found not to be obscene under either guidelines then the prosecution could not prevail. This holding was affirmed in United States v. Linetsky, 533 F.2d 192 (5th Cir. 1976). In applying the standards in this case the court will look both to the Roth-Memoirs and the Miller guidelines and if the movie is not obscene under either it should have copyright protection.

At the trial of this case neither party utilized the services of an expert on the obscenity issue. This court, therefore, must determine this issue based on its viewing of the movie and applicable Supreme Court guidelines. The court finds that the movie is obscene under the guide-

lines of both Roth-Memoirs and Miller. The copyright covering the movie is not entitled to the protection from infringement by the defendants.

For the foregoing reasons, the court is of the opinion that all relief sought by the plaintiffs herein should be denied. A judgment will be entered accordingly.